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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/827,772  | 04/06/2001  | David Girouard       | VIRAGE.028A         | 7368             |
| 20995   | 7590        | 06/20/2005           | EXAMINER            |                  |
| KNOBBE MARTENS OLSON & BEAR LLP<br>2040 MAIN STREET<br>FOURTEENTH FLOOR<br>IRVINE, CA 92614 |             |                      | BAROT, BHARAT       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2155                |                  |

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/827,772

Applicant(s)

GIROUARD ET AL.

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**RESPONSE TO AMENDMENT**

1. Claims 1-23 remain for further examination.

**The new grounds of rejection**

2. Applicants' amendments and arguments/remarks with respect to claims 1-23 filed on January 31, 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

**Drawings**

3. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the limitations "...configured to receive the video content" which is unclear about the receiving from where and "...provided encoded video to a user" which is unclear about previous action of the user; therefore, the links are missing between three major limitations (owner facility, server facility, and distribution network).

Claim 1 recites a limitation "video" in lines 13-14. There is insufficient antecedent basis for this limitation in the claim 1.

Claim 11 is missing the media content source and contains a limitation "...providing media content to a user" which is unclear about previous action of the user; therefore, the links are missing between three major limitations (owner facility, server facility, and distribution network).

Claim 17 is missing the source and destination of the video content and also missing the source and destination the video elements and contain a limitation "...delivering the encoded video to a user via a network" which is unclear about previous action of the user. Claim 17 lines 8-10 unclear about the locations of the elements.

Claim 23 recites a limitation "the server facility network server" in line 2. There is insufficient antecedent basis for this limitation in the claims 17 and 23.

As a result, the above remarks make claims 1, 11, and 17 indefinite.

Other dependent claims, which are not specifically cited above are also rejected because of the deficiencies of their respective parent claims.

**Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 11-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Jain et al (U.S. Patent No. 6,567,980). Jain's patent meets all the limitations for claims 11-23 recited in the claimed invention.

8. As to claim 11, Jain et al disclose a system for delivering media content services over a network (figure 1; column 2 lines 5-39; and column 3 line 50 to column 4 line 9), comprising: media content to which a content owner has rights (figure 7; and column 7 lines 23-34); a content owner facility comprising a content owner network server (figure 1; and column 4 lines 5-18); a service facility comprising; a video processing module configured to extract metadata from the media content and encode the media content (figure 1; and column 4 lines 1-18); and a hosted video application module configured to provide video elements for display on the content owner facility network site (figures 6-7

and 11-12; column 6 line 40 to column 7 line 36; and column 10 line 50 to column 11 line 50); and a content distribution network providing media content to a user (figure 1; column 3 lines 50-55; and column 12 line 60 to column 13 line 28).

9. As to claim 12, Jain et al disclose that the content owner facility further comprises a network server (figure 1; and column 4 lines 5-18).

10. As to claims 13-14, Jain et al disclose that the network is the Internet (column 1 lines 60-63; and column 5 lines 53-60); and the network server is a web server (figures 15-16; and column 12 line 60 to column 14 line 25).

11. As to claims 15-16, Jain et al disclose that the video elements include HTML instructions; and the media content is encoded video content (figures 1 and 15; column 3 line 50 to column 4 line 18; and column 12 line 60 to column 13 line 33).

12. As to claims 17-23, they are also rejected for the same reasons set forth to rejecting claims 11-16 above, since claims 17-23 are merely a method of operation for the apparatus defined in the claims 11-16. Additionally, Jain et al teach that storing the video index in a database (figure 7; and column 7 lines 15-36); providing search results information (figures 16-17; and column 13 line 35 to column 15 line 10); and managing the service facility network server via an administration module (figures 7, 9, and 15; column 9 lines 9-30; and column 12 line 60 to column 13 line 11).

**Allowable Subject Matter**

13. Claims 1-10 are allowable over the cited prior art of record.

**Contact Information**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached at (571) 272-4001.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

June 10, 2005

  
**BHARAT BAROT**  
**PRIMARY EXAMINER**